

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appellant:

CHARLES A. LIEDER
LLOYD E. FUNK
DAVID A. BARKER

Group Art Unit: 1714

Examiner: C. Toomer

Filed: April 21, 2000

Serial No.: 09/556,852

**For: GASOLINE-OXYGENATE BLEND
AND METHOD OF PRODUCING
THE SAME**

Attorney Docket No.: 013129/00025

APPELLANTS' REPLY BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby submits this Reply Brief, in triplicate, in accordance with 37 C.F.R. § 41.41, in order that Appellant may respond to new points of argument raised in the Examiner's Answer. The Examiner's Answer was dated July 25, 2007, and this Reply Brief is accordingly timely filed.

NEW POINT RAISED IN THE EXAMINER'S ANSWER

Claims 1-9, 17-22, 26-40 stand rejected under 35 U.S.C. § 112, First Paragraph and Claims 1, 4-10, 13-18, and 21-29 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,679,117 (“*Jarvis*”). The present Reply will discuss the Examiner’s new arguments with respect to the rejection of Claims 5-6 and 14 as being anticipated by *Jarvis* based on inherency. The Appellants respond to this new point in the following.

APPELLANTS’ REPLY

The Examiner’s Answer states “Appellant argues that claims 5-6 and 13 are not anticipated by *Jarvis* because the examiner has not argued that the rejection of the claims is based on inherency. The examiner respectfully disagrees. In the Final Office action, p. 5, the examiner states ‘*Jarvis* teaches the same composition as set forth in the present invention. Therefore, *Jarvis* would inherently meet the limitations of reducing toxic air pollutants emissions.’” (Examiner’s Answer, p. 8).

To anticipate a claim, a reference must disclose every limitation of the claimed invention either explicitly or inherently. *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1431 (Fed. Cir. 1997). The purpose of inherency is to accommodate those situations where the reference omits information that is within the common knowledge of technologists. *See Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). The Examiner must show “a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990).

Respectfully, the Examiner has not shown a basis in fact or a technical reasoning to support the alleged inherent limitation of reducing toxic air pollutant emissions. As stated in the

Appeal Brief, *Jarvis* discloses a reaction product, not a blend, of gasoline and an oxygenate. *Jarvis* fails to disclose a *blend* of gasoline and oxygenate. The points noted in the Declaration of Charles A. Lieder, Ph.D., under 37 C.F.R. § 1.132, submitted with Response to Office Action of February 10, 2003, filed on April 9, 2003, established that *Jarvis* was directed to a chemical reaction and not a blend. *Jarvis* does not disclose or teach that blends will inherently reduce toxic air pollutants as required by these claims. *Jarvis*'s disclosure provides no basis for an inherency of an element of a blend. Accordingly, Claims 5-6 and 14 are not inherently anticipated by *Jarvis*.

CONCLUSION

In light of Appellants' Appeal Brief and this Reply, the rejection of Claims 1-9, 17-22, 26-40 under 35 U.S.C. § 112, First Paragraph and Claims 1, 4-10, 13-18, and 21-29 under 35 U.S.C. § 102(b) over *Jarvis* should be reversed.

Respectfully submitted,

Date: August 27, 2007

/Steven S. Boyd/
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